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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,272	08/13/2001	Christoph Kirsch	0147-0224P	3234
2292	7590	07/28/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MARVICH, MARIA	
			ART UNIT	PAPER NUMBER

1636

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8M-
Office Action Summary

Application No.

09/831,272

Applicant(s)

KIRSCH ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-7,9-21 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2,3,8,22 and 41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

This office action is in response to a response to a restriction requirement filed 5/3/04. Claims 41-46 have been added. Claims 1, 4-7 and 9-21 have been withdrawn as drawn to non-elected subject matter. Claims 1-46 are pending in the application.

Election/Restrictions

In a preliminary amendment filed 8/12/03, applicants state that Group XI (claim 2, 3, 8 and 22) has been elected with traverse as they read on SEQ ID NO:11 in response to an oral restriction requirement. Neither the restriction requirement nor the reason for traversal is of record. Furthermore, claims 41-46 have been added by this amendment.

A subsequent restriction requirement was made 1/28/04 of claims 2, 3, 8, 22 and 41-46 requiring election of one of the sequences of SEQ ID NOs: 5-16 and one of the sequences of SEQ ID NO:1 or 2. Applicants' election with traverse of the claims 2, 3, 8, 22 and 41-46 as they read on SEQ ID NO:11 and SEQ ID NO:2 in the reply filed on 5/4/04 is acknowledged. The traversal is on the ground(s) that claim 2 provides the required single general inventive concept under PCT Rule 13.1 and SEQ ID NO: 1 and 2 are not essential elements of claim 2. Furthermore, SEQ ID NO:1 and 2 are structurally related to each other and therefore possesses the required special technical feature.

Each sequence has different structural and functional properties that are special technical features. Moreover, it has been decided that, due to the high burden placed on the Office to search sequences, ONE sequence constitutes a reasonable number for examination purposes. Applicant is required to elect ONE independent and distinct sequence. Examination will be restricted to only the one elected sequence. The search of

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no more than one selected sequences may include the complements of the selected sequence and where appropriate, may include subsequences within the selected sequence (i.e. oligomeric probes and/or primers).

See Examination of Patent Applications Containing Nucleotide Sequences, 1192

O.G. 68 (November 19, 1996) e.g.

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, select to a restriction requirements pursuant to 35 U.S.C. 1121 and CFR 1.141 et seq. Nevertheless, to further aid the biotechnology industry to protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application.

Upon reconsideration, the requirement that applicant elect either SEQ ID NO:1 or SEQ ID NO:2 is dropped. Otherwise, the requirement is still deemed proper and is therefore made FINAL. Claims 1, 4-7, 9-21 and 42-46 have been withdrawn as drawn to non-elected subject matter. Claims 2, 3, 8, 22 and 41 are under examination in the instant application.

Information Disclosure Statement

Information Disclosure Statements filed 5/9/01 and 8/20/01 have been identified and the documents considered. The signed and initialed PTO Form 1449s has been mailed with this action.

Sequence Compliance

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825. Specifically, figure 4 contains 6 unique sequences that are not all identified by the 5 sequence identifier numbers provided in the figure description. The sequences can be found in the sequence listing, therefore it would be remedial to insert the appropriate SEQ ID NO:s.

Drawings

Formal drawings have been submitted which fail to comply with 37 CFR 1.84. Please see the enclosed copy of the form PTO-948 of 1/4/02.

Specification

The disclosure is objected to because of the following informalities: The brief description of Figure 7 is objected to as the figure contains an A and B portion that are not so described. Appropriate correction is required.

Furthermore, the disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Specifically, page 25, line 4, 5, 6, 7 and 9 contain hyperlinks. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a). There are two oaths associated with the instant application. The first filed 7/2/01 is incorrectly identified as associated with the instant serial number 09/831,272 but otherwise is unrelated to the instant invention. The second oath filed with the instant specification incorrectly identifies the specification by the wrong serial number, 09/842,767. A new oath with the correct serial number is required.

Claim Objections

Claim 41 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Specifically, following election of SEQ ID NO:11, claim 2 and claim 41 recite that the chimeric promoter comprises at least one cis-element of SEQ ID NO:11.

Claims 2, 3, 8, 22 and 41 are objected to as encompassing non-elected subject matter. Appropriate correction is required.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 8, 22 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3, 8, 22 and 41 are vague and indefinite in that the metes and bounds of “local gene expression” are unclear. The term “local” is a relative one for which neither the specification nor the prior art prescribes a standard meaning thus it is unclear if this “local expression” is limited to the plant or to the exact site of pathogen infection or in between.

Claim 8 recites the limitation "at least two of said *cis*-acting elements" in claim 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 is vague and indefinite in that the metes and bounds of “A *cis*-acting element” are unclear. It is unclear if the recited *cis*-acting element is different from “the” *cis* element recited in claim 2 or a different *cis* element.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 22 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by van de Loch et al (EMBO J, 1990, vol 9(9) p 2945-2950; see entire document).

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Van de Locht et al teach a chimeric promoter comprised of the sequence found in SEQ ID NO:11 and the core CHS promoter which comprises those elements necessary to initiate transcription i.e. TATA Box (see e.g. page 2948, column 1, paragraph 1). The portion of the PR2 promoter used in the chimeric construct shown in figure 6 extends from -168 to -43 which covers the region of SEQ ID NO:11 as highlighted in figure 3.


Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (571)-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERRY LEFFERS, Examiner
PRIMARY EXAMINER
Maria B Marvich, PhD
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July 21, 2004